

**REMARKS**

Claims 1, 3-40 and 42-45 are currently pending in the subject application and are presently under consideration. Favorable reconsideration of the subject patent application is respectfully requested in view of the comments herein.

**I. Rejection of Claims 1, 3, 5-8, 10, 15-19 and 21 Under 35 U.S.C. §102(b)**

Claims 1, 3, 5-8, 10, 15-19 and 21 stand rejected under 35 U.S.C. §102(b) as being anticipated by Robinson (US Patent 5,918,014).

Withdrawal of this rejection is respectfully requested for at least the following reasons. Robinson does not teach or suggest applicant's claimed invention.

For a prior art reference to anticipate, 35 U.S.C. §102 requires that "each and every element as set forth in the claim is found, either expressly or inherently, in a single prior art reference. In re Robertson, 169 F.3d 743, 745, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (quoting *Verdegaal Bros., Inc. v. Union Oil Co.*, 814 F.2d 628, 631, 2USPQ2d 1051, 1053 (Fed. Cir. 1987)).

Contrary to assertions made in the Advisory Action, the limitation of "determining and/or evaluating a ***cost of accessing/returning*** to the resources in an ***unloaded condition***", does appear in independent claims 1, 15, and 17 of the subject invention. Independent claim 1 recites "evaluating a ***cost of accessing resources in unloaded condition***", and independent claim 15 recites "means for evaluating a cost to ***retrieve resources in a non-downloaded condition***." Also, the limitation of "***determining a cost of accessing*** a resource in an ***unloaded condition***" is recited in independent claim 17.

Applicant's claimed invention in part is directed to methods and systems of downloading /distributing resources (*e.g.*, software components) among intermediate storage facilities and/or receivers, wherein a ***cost of accessing/returning*** to the resources in an ***unloaded condition*** is determined. For example, the probability of having to return to a CD-ROM resource during a life cycle of a product can be evaluated/determined, and an associated cost employed to make decisions regarding a download. Also, the claimed invention further enables changing a ***constraint associated with the intermediate storage*** facility, based on an associated change in value and cost. For example, a read access time or capacity of such intermediate storage facility

can be changed, based on an associated variance in value and cost. As such, an intelligent installment/distribution of resources can be provided, which conserves storage resources. Such aspects of applicant's claimed invention are not taught or suggested by Robinson.

Rather, Robinson is directed to showing new ads to different people (typically without a request being made for such new ads), based on their past activities. Robinson tracks activities of a subject in an interactive medium to determine which advertisement to present to the user. Robinson does not teach or suggest: “minimizing *request-to receive time*”; or “evaluating a cost of *changing a constraint* associated with the intermediate storage facility,” and “*returning to resources in unloaded condition*”; as in applicant's claimed invention. (There logically exists a distinction between “cost of *not accessing* a resource” as purportedly disclosed in Robinson – versus – “cost of *accessing* a resource in an *unloaded condition*”, as in the claimed invention).

Independent claim 1 recites “distributing [...] *to minimize total request-to-receive time*”, and “evaluating a *cost of accessing resources in unloaded condition*”. Likewise, independent claim 15 recites “means for optimizing distribution over intermediate storage facilities *to minimize total request-to-receive times*”, and “means for evaluating a cost to *retrieve resources in a non-downloaded condition*.” Also, the limitations of “*changing a storage capacity of the intermediate storage*”, and “*determining a cost of accessing* a resource in an *unloaded condition*” are respectively recited in independent claims 16 and 17.

In view of the at least above comments it is readily apparent that Robinson does not teach or suggest the subject invention as recited in independent claim 1 (and claims 3, 5-8, 11, 13, 14 dependent therefrom), independent claim 15, independent claim 16, independent claim 17 (and claims 18-20 dependent therefrom). Withdrawal of this rejection is respectfully requested.

## **II. Rejection of Claim 4 Under 35 U.S.C. §103(a)**

Claim 4 stands rejected under 35 U.S.C. §103(a) as being obvious over Robinson (US Patent 5,918,014). Claim 4 depends from independent claim 1, and as explained *supra* Robinson does not teach or suggest the invention as recited in independent claim 1. Withdrawal of this rejection is respectfully requested.

### III. Rejection of Claims 9, 11, 12 and 20 Under 35 U.S.C. §103(a)

Claims 9, 11, 12 and 20 stand rejected under 35 U.S.C. §103(a) as being obvious over Robinson in view of Drewry *et al.* (US Patent 5,925,100). Claims 9, 11, 12 depend from independent claim 1, and claim 20 depends from independent claim 17. As explained *supra*, Robinson does not teach or suggest applicant's invention as recited in the subject independent claims, and Drewry *et al.* fails up to make for the aforementioned deficiencies of Robinson with respect to such independent claims. Withdrawal of this rejection is respectfully requested.

### IV. Rejection of Claims 13 and 14 Under 35 U.S.C. §103(a)

Claims 13 and 14 stand rejected under 35 U.S.C. §103(a) as being obvious over Robinson in view of Drewry *et al.* in further view of Cherkasova *et al.* (US Patent 6,425,057). Claims 13, 14 depend from independent claim 1, and Drewry *et al.* in view of Cherkasova *et al.* fail to make up for the aforementioned deficiencies of Robinson with respect to independent claim 1. Withdrawal of this rejection is respectfully requested.

### V. Rejection of Claims 22-31, 39, 40 and 42-45 Under 35 U.S.C. §103(a)

Claims 22-31, 39, 40 and 42-45 stand rejected under 35 U.S.C. §103(a) as being obvious over Robinson and Drewry *et al.* in view of Cherkasova *et al.* and further in view of Fischer *et al.* (US Patent 6,438,672).

Independent claim 22 recites “**minimizing** total expected request to receive time [...] and **changing a storage** space associated with the intermediate storage facility, based on the **minimizing act.**” As explained earlier, such aspects of the claimed invention are not taught or suggested by Robinson. Moreover, Drewry *et al.* and Cherkasova *et al.* in view of Fischer *et al.* fail to make up for the aforementioned deficiencies of Robinson with respect to independent claim 22.

Likewise, independent claim 39 recites “means for evaluating a cost to return to resources in non-downloaded condition”, and independent claim 40 recites “determining a cost of **returning to resources in an unloaded condition**”; as explained earlier Robinson fails to teach or disclose such aspects of the claimed invention. Furthermore, Drewry *et al.* and Cherkasova *et al.* in view of Fischer *et al.* fail to make up for the aforementioned deficiencies of Robinson with respect to independent claims 39 and 40.

In view of the at least above comments it is readily apparent that the cited references do not teach or suggest the subject invention as recited in independent claim 22 (and claim 23-31 dependent therefrom), independent claim 39, and independent claim 40 (and claims 42-45 dependent therefrom). Withdrawal of this rejection is respectfully requested.

**VI. Rejection of Claims 32-38 Under 35 U.S.C. §103(a)**

Claims 32-38 stand rejected under 35 U.S.C. §103(a) as being obvious over Robinson in view of Drewry *et al.*, in view of Cherkasova *et al.* and further in view of Fischer *et al.* in further view of Ganz *et al.* (US Patent 6,049,549).

Independent claim 32 recites “***a first determining*** a probability [...] ***a second determining*** [...] ***a change in value of*** storing the resource on a first storage facility versus [...] a second storage facility; determining, a ***change in cost of*** storing the resource on the first storage facility versus storing the resource on the second storage facility; determining, for each resource, a value density in a knapsack approximation procedure based on the change in value ***via the first determining act and the second determining act***[...]”. Accordingly, the knapsack approximation procedure of the subject innovation is based on the first and second determining act.

Such aspects of the claimed invention are not taught or suggested by the knapsack procedure of Ganz *et al.*, which merely discloses existence of such procedure, and applies it to a capacity distribution of a communication system. Moreover, Robinson in view of Drewry *et al.*, and in view of Cherkasova *et al.* and further in view of Fischer *et al.* fail to make up for the aforementioned deficiencies of Ganz *et al.* with respect to independent claim 32.

Moreover, the Office Action relies on improper motivation to combine and/or modify the references. In general, the rationale proffered is to achieve benefits identified in applicant’s specification, which overcome problems associated with conventional systems/methods. Applicant’s representative respectfully submits that such rationale is an unacceptable and improper basis for a rejection under 35 U.S.C. §103. In essence, the Examiner is basing the rejection on the assertion that it would have been obvious to do something not suggested in the art because so doing would provide advantages stated in applicant’s specification. This has been condemned by the CAFC. *See, for example, Panduit Corp. v. Dennison Manufacturing Co.*, 1

USPQ2d 1593 (Fed. Cir. 1987). It is noted that even if the references are combined, applicant's claimed invention does not result.

**CONCLUSION**

The present application is believed to be in condition for allowance in view of the above comments. A prompt action to such end is earnestly solicited.

In the event any fees are due in connection with this document, the Commissioner is authorized to charge those fees to Deposit Account No. 50-1063 [MSFTP291US].

Should the Examiner believe a telephone interview would be helpful to expedite favorable prosecution, the Examiner is invited to contact applicant's undersigned representative at the telephone number below.

Respectfully submitted,

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